

United States Patent &amp; Trademark Office; U.S. DEPARTMENT OF COMMERCE

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>	Docket Number (Optional) 058268.00370
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed Name _____	Application Number:  10/805,233
	Filed: March 22, 2004
	First Named Inventor:  Wen-Cheng TSENG, <i>et al.</i>
	Art Unit: 2182  Examiner: Eron J. SORRELL

**Mail Stop AF**  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).


Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.  
Registration No. \_\_\_\_\_

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 September 13, 2007  
 Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.



## PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 9041

Wen-Cheng TSENG, *et al.*

Art Unit: 2182

Application No.: 10/805,233

Examiner: Eron J. SORRELL

Filed: March 22, 2004

Attorney Dkt. No.: 058268.00370

For: NETWORK DEVICE HAVING A FLEXIBLE EEPROM FOR SETTING  
CONFIGURATION SETTINGS

### **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

September 13, 2007

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005, Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 22-42 in the above identified application. Claims 22-42 were finally rejected in the Office Action dated June 22, 2007. Applicants filed a Response to the Final Office Action on August 7, 2007, and the Office issued an Advisory Action dated August 29, 2007, maintaining the final rejections of claims 22-42. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

Claims 22-25, 27-32, 34-39, 41, and 42 were rejected under 35 §103(a) as being unpatentable over Egbert (U.S. Patent No. 6,407,960) in view of Chieng (U.S. Patent No. 6,035,346). Applicants respectfully submit that this rejection contains at least two clear errors that warrant withdrawal of this rejection.

**Clear Error 1** - Egbert and Chieng, combined or individually, fail to disclose or suggest “determining from a header whether any default value of the network device should be updated and fetching at least one configuration instruction from a memory when the determining step determines that the network device should be updated,” as recited in independent claim 22, and similarly recited in claim 36.

Egbert generally describes a method by the external memory interface 16 of storing register data values in selected device registers 12. The external memory interface 16 initiates reading of the external memory 14 in step 50 following a detected reset condition on the device 10 and in response to detection of the external memory device 14 by the memory sensor 18. In particular, the external memory interface 16 begins reading the first memory location of the external memory 14, which corresponds to an even-numbered location 26. The address decoder logic 22 reads the register address value from the even memory location 26 in step 52, and determines in step 54 whether the most significant bit of the register address value is set to 1. See column 3, lines 50-56.

Chieng generally describes a method for reprogramming boot instructions in an adapter card in a computer system. Specifically, the PCI device's programmable read only memory can be reprogrammed without storing any reprogramming instructions in the PROM itself by allowing a host processor to control an intelligent Peripheral Component Interface device's reset logic. During reprogramming operations the host processor commands the PCI device into a reset-and-hold mode. During this time the host processor downloads reprogramming instructions and replacement code into the PCI's random access memory. When released from reset, the PCI device executes the reprogramming code downloaded by the host processor. See abstract of Chieng.

Certain embodiments of the present invention provide a new approach for chip and network component vendors to provide system integrators a dynamic configuration using a low cost EEPROM. With this approach, system integrators will have flexibility to change the default values of all configurable registers inside a network device, such as

switch/hub chip or components on a PC board. A network device will be able to update configuration setting either through the low cost EEPROM or through a microprocessor interface. According to an example of the present invention, it is continuously determined whether the RESET signal is set to inactive. If the RESET signal is determined to be inactive, the header of the EEPROM is read. Determination and comparison of a key is made with respect to a predefined number in the chip. Once the match is found, then instructions are read from the EEPROM and the corresponding register value is updated.

As discussed below, Egbert and Chieng, whether considered individually or in combination, fail to disclose or suggest all of the elements of the claims, and therefore fail to provide the advantages and features discussed above.

Applicants respectfully submit that the combination of Egbert and Chieng fails to disclose or suggest, at least, “determining from a header whether any default value of the network device should be updated and fetching at least one configuration instruction from a memory when the determining step determines that the network device should be updated,” as recited in independent claim 22 and similarly recited in claim 36.

The Office Action took the position that Egbert discloses “determining from a header whether any default value of the network device should be updated and fetching at least one configuration instruction from a memory when the determining step determines that the network device should be updated.” However, Egbert merely discloses reading of register address value from the even memory location 26, and determining of the most significant bit of the address value set to 1. See column 3, lines 55-59. Egbert does not disclose **determining** from a header **whether** a default value **should be updated** or **fetching** configuration instructions from memory when it is determined that the device **should be updated**.

The Office Action took the position that Egbert teaches a network device that receives configuration instructions from an external memory device. Further, the Office Action took the position that Egbert teaches reading a header (MSB) from a location in

the external memory to determine if any values in the network device are to be updated. Claim 1 recites the steps of determining from a header whether any default value of the network device should be updated and fetching at least one configuration instruction from a memory when the determining step determines that the network device should be updated. However, Egbert does not disclose or suggest such determining and fetching steps. Instead, the method of Egbert merely reads a register address value from an external memory. See column 4, lines 34-35. There is no teaching or suggestion in Egbert that any steps of **determining whether** any value of the network device should be **updated**. This omission constitutes clear error that requires withdrawal of the rejection.

**Clear Error 2** - The combination of Egbert and Chieng fails to disclose or suggest that “the configuration instruction interpreter is configured to interpret the received configuration instructions such that the corresponding values are mapped corresponding default values of the register file,” as recited in claim 29.

Egbert merely discloses the reading of register address values and respective data values from external memory 14, and storing the register data values in the destination device registers 12. See column 4, 1-10. Egbert does not disclose or suggest that the device is configured to **interpret** received configuration instructions so that the corresponding values are mapped to corresponding default values of the register file. Chieng also fails to disclose or suggest this limitation of claim 29. Accordingly, the combination of Egbert and Chieng fails to disclose or suggest, “wherein the configuration instruction interpreter is configured to interpret the received configuration instructions such that the corresponding values are mapped corresponding default values of the register file,” as recited in claim 29. This omission constitutes clear error that requires withdrawal of the rejection.

The Office Action also took the position that Egbert teaches the network device including a memory interface that receives configuration instructions and the addresses read from the external memory are mapped to the register file in the network device. The Office Action also took the position that Egbert teaches the network device that reads the

internal memory and interprets what registers to reprogram and what data to reprogram the device with. Claim 29, however, recites a network device including a microprocessor, a memory, and a register file containing default values for the network device. Egbert does not disclose or suggest such network device. Rather, Egbert teaches that specifying the destination device registers 12 for storage of respective register data values stored in odd-numbered memory locations 28 within the external memory 14. See column, lines 38-42. Egbert merely discloses that the register values specifying the destination device registers.

In view of the above, reliance on Egbert, and Chieng as to teaching or suggesting each and every recitation of independent claims 26 and 36 and related dependent claims is clearly erroneous; This omission constitutes clear error that requires withdrawal of the rejection. The remaining rejections suffer from the same clear errors, as explained in detail at pages 10-12 of the response filed on August 7, 2007.

Applicants respectfully submit that Egbert and Chieng, individually or combined, fail to disclose or suggest all of the elements of the claimed invention. These distinctions are more than sufficient to render the claimed invention unobvious. It is respectfully requested that all of claims 22-42 be allowed, and this application passed to issue.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional feels may be charged to counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form  
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